

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REISSUE APPLICATION

Applicants : Youman et al.
Reissue : 09/313,532 Conf. No. : 4047
Application No.
Filed : May 13, 1999
Patent No. : 5,629,733 Issued: May 13, 1997
For : ELECTRONIC TELEVISION PROGRAM GUIDE SCHEDULE
SYSTEM AND METHOD WITH DISPLAY AND SEARCH OF
PROGRAM LISTINGS BY TITLE
Art Unit : 2424
Examiner : Joseph G. Ustaris

New York, New York 10036
August 24, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Madam:

Pursuant to 37 C.F.R. § 41.41(a), appellants are filing this Reply Brief in reply to the Examiner's Answer dated June 23, 2009 ("the Examiner's Answer") and in support of their appeal from the final rejection of claims 24-27, 29-43, and 45-55¹ in the Final Office Action dated December 10, 2007 ("Final Office Action"). Appellants previously filed a Notice of Appeal

¹ The Final Office Action rejected claims 24-55. However, claims 28 and 44 were canceled.

on June 9, 2008 and an Appeal Brief on April 1, 2009 ("Appeal Brief") in connection with this case.

I. Status of Claims

Claims 1-23 are allowed. Claims 24-27, 29-43, and 45-55 are finally rejected in this application and are on appeal. Claims 28 and 44 were canceled previously. Claims 1-27, 29-43, and 45-55 are pending this application.

II. Ground of Rejection to be Reviewed on Appeal

The grounds of rejection to be reviewed on this appeal are whether the rejections of claims 24-27, 29-43, and 45-55 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter is proper.

III. Introduction

Appellants maintain the position that claims 24-27, 29-43, and 45-55 of the present application are patentable and that no impermissible recapture has occurred.

IV. Summary of the Examiner's Answer

The Examiner's Answer maintains the § 251 rejections of claims 24-27, 29-43, and 45-55 from the December 10, 2007 Final Office Action and restates the same grounds of rejection from that Final Office Action. In particular, the Examiner is of the view that recapture has occurred because appellants' reissue claims do not include the "cycling" and "assigning" features of the issued patent claims. The Examiner is also of the view that appellants' reissue claims are not "materially narrowed in other respects" so as to avoid recapture under the third step of the *North American Container* test.

V. Summary of Appellants' Reply

The Examiner's rejection at bottom relies upon an interpretation of the *Clement/North American Container* three-part test - one apparently held by the Board and endorsed by the Director² - which considers the "surrendered subject matter" for purposes of determining whether a recapture occurs under substep 3(a) of the *Clement* test as including the territory falling between the scope of the application claim which was canceled or amended, and the patent claim which was ultimately issued.³ This interpretation eschews the standard set out in Federal Circuit precedent, and in the Board's opinion in *Eggert*⁴, where the "surrendered subject matter" is deemed to be the canceled or amended claim. It is based on the Board's interpretation of the Federal Circuit's opinion in *North American Container*, an interpretation which, appellants respectfully submit, is incorrect. *North American Container* was not a departure from the prior standard of "surrendered subject matter." Under the proper standard no recapture has occurred because appellants' reissue claims are still narrower than the original patent claims, and are narrower precisely in an area related to the original prior art rejection (i.e., the reissue claims specify a specific means for selecting and assigning characters).

Even if, *arguendo*, recapture under step 3(a) of *Clement* should be based on the issued patent claims rather than

² See *Ex Parte Aleles*, 2006 WL 3769596 (Bd.Pat.App. & Interf. 2006), and MPEP § 1412.02(I.C) (8th ed., Rev. 7, July 2008).

³ See *Aleles*, 2006 WL 3769596; see also *Ex Parte Tano*, 2009 WL 1796029 (Bd.Pat.App. & Interf. 2009).

⁴ *Ex Parte Eggert*, 2003 WL 21542454 (Bd.Pat.App. & Interf. 2003).

the pre-amendment claims, the reissue claims still avoid recapture because they are narrower in an aspect related to the prior art rejection over Reed (and therefore fall instead under 3(b)). Moreover, the Examiner's reasoning that appellants' "wireless remote control" and "nonalphanumeric keys" limitations are not "germane to a prior art rejection" because they were "not amended or argued in the original prosecution to overcome an art rejection" is baseless.⁵ The Examiner provides no support for such a standard -- namely that one can only "materially narrow" a reissue claim by using amendments made or argued in original prosecution -- and Appellants submit that it is actually contrary to Federal Circuit precedent.

Various board opinions suggest that to be "materially narrowed in other respects," a reissue claim feature must be only for "overlooked aspects" of the invention.⁶ Appellants respectfully submit that this is inconsistent with Federal Circuit precedent. However, even if the Board decides that the only way appellants' claims can escape recapture is through the use of narrowing amendments claiming "overlooked aspects" of the invention, appellants' claims are still allowable. Applying the Federal Circuit's interpretation of when claim limitations may define an "overlooked aspect,"⁷ it is clear that appellants' "wireless remote control" and "nonalphanumeric keys" limitations were "overlooked" because they were neither present in the original patent application nor argued during prosecution to

⁵ Examiner's Answer at 7.

⁶ See *Aleles*, 2006 WL 3769596; *Ex Parte Browning*, 2007 WL 1787608 (Bd.Pat.App. & Interf. 2007); *Ex Parte Lanier*, 2009 WL 789925 (Bd.Pat.App. & Interf. 2009).

⁷ *Hester v. Stein*, 142 F.3d 1472 (Fed. Cir. 1998).

overcome prior art. Indeed, the Examiner concedes these exact points in the Examiner's Answer.⁸

Accordingly, appellants submit that the Board should find the final rejections of claims 24-27, 29-43, and 45-55 under 35 U.S.C. § 251 to be in error and reverse the Examiner.

VI. Appellants' Reply to the Examiner's Answer Regarding Independent Claims 24 and 40

Appellants respectfully submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 251 rejection of claims 24-27, 29-43, and 45-55.

A. The Proper Starting Point For Determining Surrendered Subject Matter Is The Pre-Amendment Claim - Not The Issued Claim - And Eliminating the Amendment Is Permissible So Long as the Reissue Claims Are "Materially Narrowed in Other Respects"

Federal Circuit precedent was clear leading up to *North American Container* (and appellants believe still is)- the surrendered subject matter under substep 3(a) of *Clement* was the amended or canceled patent application claim - not the issued patent claim.⁹ Indeed the Board previously in *Eggert* adopted

⁸ Examiner's Answer at 6-7.

⁹ See *Ball v. United States*, 729 F.2d 1429, 1436 (Fed. Cir. 1984) ("The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader [s]cope than those claims that were canceled from the original application") (emphasis in original); *In re Clement*, 131 F.3d 1464, 1469 (Fed. Cir. 1998) ("Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim **before cancellation or amendment** is unpatentable...") (emphasis added); *Hester*, 142 F.3d at 1482 ("[W]e must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. When the surrender occurs by way of claim amendment or cancellation, 'comparing the reissue claim with the canceled (Continued...)

this standard.¹⁰ Under this precedent, reissue claims may eliminate an amendment made during prosecution so long as the claims are materially narrowed in other respects.

The Board and the Director read *North American Container* as redefining "surrendered subject matter" under substep 3(a) to include, on a limitation by limitation basis, the scope of the claim between the original claim and the issued patent claim. This position was stated as early as 2006 in a precedential Board opinion in *Ex Parte Aleles*¹¹ and most recently in *Tano*.¹² Such a position attempts to set up a bright line rule preventing an applicant from seeking through reissue claims eliminating any amendment made during prosecution - claims that, in a material aspect, are narrower than the original patent claims but broader than the issued patent claims with respect to the added limitation.¹³

Appellants respectfully submit that the Board's (and the Director's) interpretation of *North American Container* is incorrect. *North American Container* actually confirms the standard set forth in prior Federal Circuit precedent and

(...Continued)
claim is one way to do this.'" (citing *Clement*, 131 F.3d at 1469) (internal citations omitted)).

¹⁰ *Eggert*, 2003 WL 21542454.

¹¹ See *Aleles*, 2006 WL 2769596 at *10 ("In our view, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*.")

¹² *Tano*, 2009 WL 1796029.

¹³ That is, unless they are narrowed only in "overlooked aspects." See below at 15-19.

Eggert. In *North American Container*, the application claims recited "inner walls." To obtain allowance, the applicant amended the claim to narrow the inner walls feature - specifically, the inner walls were amended to be "generally convex." The reissue claims eliminated the "generally convex" limitation, clearly "broaden[ing] the 'inner wall limitation.'" ¹⁴ But, and this is the key point, the Federal Circuit specifically noted that "the reissue claims were not narrowed with respect to the 'inner wall' limitation, **thus avoiding the recapture rule.**" ¹⁵ Thus, the reissue claims in *North American Container* would have avoided recapture even though they eliminated the "generally convex" limitation, so long as they narrowed the "inner walls" in a way pertinent to the rejection that caused the amendment to be made in the first place. ¹⁶

Thus, rather than change the standard for surrendered subject matter, *North American Container* actually confirms the aged standard of the Federal Circuit - the standard recognized by the Board in *Eggert*. Under the Board's and the Director's readings, removing a limitation added during prosecution is *de facto* impermissible. But this is not the standard of the Federal Circuit, ¹⁷ and *North American Container* does not

¹⁴ *North American Container*, 415 F.3d at 1350.

¹⁵ *Id.* (emphasis added).

¹⁶ The reissue claims stated that the "inner walls" were also of a particular diameter range. This was deemed to not sufficiently narrow the "inner walls" to avoid recapture because it was a feature from a dependent claim that had issued and also (through its dependency on the amended claim) had the "generally convex" feature. *Id.* at 1350.

¹⁷ See *Ball*, 729 F.2d at 1438 ("Thus, the principle that a claim is broadened if it is broader in any respect than the original serves to effect the bar of section 251 against reissue filed
(Continued...)

expressly attempt to make it so.¹⁸ It is still the case that one may seek reissue claims which eliminate an amendment made during prosecution, so long as one materially narrows the claim in a way related to the original rejection.

(...Continued)

later than 2 years after issuance of the original patent.... We know of no authority applying the above rule to reissue claims to the scope of canceled claims with the 2-year period for broadened reissue. Nor do we perceive the wisdom of such extension in this case.").

¹⁸ A recent *Texas Law Review* article states it quite well using *Ex Parte Browning*, 2007 WL 1787608 (Bd. Pat. App. & Interf. 2007) (unpublished), as an example of the Board's reasoning:

the *Browning* panel misreads *North American Container*, as well as the precedent, to find a divergence that does not exist. *Browning* does correctly characterize the *Eggert* panel's holding that the scope of surrendered subject matter is confined to the pre-amendment claim. But *Eggert* so held because *Clement* requires it. *Clement* explicitly notes that an amendment suggests the applicant's admission 'that the scope of the claim before the...amendment is unpatentable,' and the wording of the *Clement* framework reinforces this. The court in *North American Container* does not purport to distinguish or limit *Clement*, or to comment on it in any notable way; indeed, the court's application of the *Clement* principles via the intermediate authority is practically mechanical. If the court intended to signal a shift away from *Clement* regarding surrendered subject matter, it did not do so explicitly in *North American Container*. (*Threading the Needle: Intermediate-Scope Broadening Reissue Claims and the Recapture Rule*, 87 *Tex. L. Rev.* 827, 848 (2009)).

B. The Reissue Claims Avoid Recapture Because They Are "Materially Narrowed In Other Respects" - They Are Narrower Than The Pre-Amendment Claim In An Aspect Germane To A Prior Art Rejection.

Step 3 of the test for recapture, as stated in *North American Container* (and as used by the Examiner), involves determining "whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule."¹⁹ Comparing this to the particular recitation of substep 3 set forth in *Clement*,²⁰ it becomes clear that the analysis turns on whether the narrowing relates to, or is germane to, the prior art rejection that caused the amendment during original prosecution. In *Clement*, the Federal Circuit specifically focused on the relevance of the prior art rejections made during original prosecution, and specifically tied both substeps 3(a) and 3(b) to whether or not the "narrowing" was "unrelated" to, or "germane to" the prior art rejection:

In both *Mentor* and *Ball*, **the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis.** From the results and reasoning of those cases, the following principles flow: . . . (3) if the reissue claim is broader in some aspects but narrower than others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, **but narrower in another aspect completely unrelated to the rejection**, the recapture rule bars the claim; (b) **if the reissue claim is narrower in an aspect germane to prior art rejection**, and broader in

¹⁹ *North American Container*, 415 F.3d at 1349.

²⁰ *Clement* lists three substeps for determining "materially narrowing" for step 3.

an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.²¹

The Court went on to conclude that *Mentor* was an example of 3(a), and *Ball* was an example of 3(b).

In *Mentor*²², the claimed invention was for a male condom catheter with adhesive for securing the catheter. In response to a prior art rejection, the patentee specified that the claimed catheter "transferred" the adhesive to the inner surface of the catheter during unrolling, and without rolling the catheter inside out. The reissue claims lacked this limitation, but included other limitations that were alleged to otherwise narrow the claims. In particular, the added limitations did not relate at all to how the adhesive was transferred (they were limitations on other structural aspects of the catheter). The Court found that these limitations did not materially narrow the claims "when compared with their broadening." That is, although the specific limitations added during prosecution concerning the transfer of adhesive were eliminated, there were no other limitations directed to how the adhesive was transferred.

In *Ball*²³, the claimed invention was an antenna assembly intended for use on missiles. The claimed feature at issue was the number of "feed lines" connected to a part of the antenna. Two claims allowed for a single feed line. These included an independent claim which recited a "feed means", and a dependent claim which called for "at least one" feed line.

²¹ *Clement*, 131 F.3d at 1470 (emphasis added).

²² *Mentor v. Coloplast*, 998 F.2d 992 (Fed. Cir. 1993).

²³ *Ball*, 729 F.2d 1429.

Another claim called for "a plurality of leads." In response to a prior art rejection, the applicant cancelled the claims that allowed for a single feed line. During reissue, claims were added directed to a single feed line embodiment, but which replaced the "feed means" with a "single feed assembly." The Court found that the "feed assembly" was more limited than the "at least one" feed means limitation in the cancelled claim.²⁴ This narrowing was germane to the prior art rejection - it narrowed the means by which the conductors of the antenna were fed.

Although the facts of *Clement* are slightly more complicated than *Mentor* and *Ball* (which *Clement* categorizes to address its own facts), it too demonstrates that "materially narrowed" means narrowed, with respect to an original claim, in a way related to the prior art rejections. The claimed invention in *Clement* was for a method of treating a mixture of printed and contaminated waste paper for use in the manufacture of pulp and paper boards. In response to a series of rejections, the patentee narrowed the claims in a number of areas. The court examined the reissue claims to determine whether it was narrower than the original application claims in each of the areas in which the claims had been amended in response to prior art rejections. The Court found that the reissue claim was narrower in only one area, and that it had eliminated each of the other added limitations without any other narrowing related to the rejection that caused the amendment.²⁵ It determined that "[o]n balance, [the reissue claim] is broader

²⁴ *Ball*, 729 F.2d at 1437.

²⁵ *Clement*, 131 F.3d at 1470-71.

than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution."

Clement's progeny also demonstrate that "materially narrowed in other respects" means narrowed, as compared to the original claim, in a matter related to a prior art rejection. As noted above, the Court in *North American Container* recognized that the reissue claims "were not narrowed with respect to the 'inner wall' limitation."²⁶ In *Pannu*,²⁷ the claimed invention was directed to an artificial intraocular lens.²⁸ The claims were narrowed over prior art to define a particular shape for the haptics²⁹ of the lens. The reissue claims eliminated this feature, but had other limitations related to the positioning and dimensions of other parts of the lens. The Court found that because the narrowing was unrelated to the shape of the lens, the claims were not "narrowed in any material respect compared with their broadening."³⁰

Appellants' reissue claims are narrower than the original patent claims in a way directly related to the prior art rejection that caused the original application claims to be amended. The claimed invention is directed to a character selection feature for an electronic television program guide that allows a user to search for programs using a remote control

²⁶ *North American Container*, 415 F.3d at 1350.

²⁷ *Pannu v. Storz*, 258 F.3d 1366 (Fed. Cir. 2001).

²⁸ An intraocular lens is an artificial plastic lens that may be implanted in an eye to replace a natural lens.

²⁹ Haptics are elements that are attached to part of the lens and contact internal tissue in the eye for the purpose of positioning the optic of the lens.

³⁰ *Hester*, 142 F.3d 1472.

with relatively limited input options, when compared to the prior art technique of using an alphanumeric keyboard. When the application was originally filed, claim 1 was silent as to the character selection approach, reciting simply "selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title, where n is greater than or equal to one." Claim 1 was later amended to include a specific approach - the "cycling feature" -- in order to overcome a prior art rejection that employed a full-featured keyboard to search an encyclopedia index on a personal computer:

wherein said video display generator displays said n characters and said selection means comprises means for causing said character displays to cycle forward and backward through a plurality of alphanumeric characters and means for assigning one of said alphanumeric character to each of said n characters

The pending reissue claims 24 and 40 do not include the "cycling" feature, but instead specify another technique in which a user may select characters, i.e., "with the wireless remote control from a plurality of displayed alphanumeric characters by changing from a first character to a second character" using "nonalphanumeric keys" of the remote control. The reissue claims 24 and 40 do not seek to recapture the surrendered scope of the originally filed application claims. That is, the reissue claims do not cover all means for selecting the characters. Rather, appellants are pursuing narrower claims (in this regard) that cover character selection using another approach. This is precisely the type of "materially narrowing" that Federal Circuit precedent requires to avoid recapture.

On pages 6-7 of the Examiner's Answer, the Examiner states: "the appellants are incorrect that the reissue claims

are narrower in an aspect germane to the prior art rejection because the limitations of 'a wireless remote control, nonalphanumeric keys, and changing from a first character to a second character using the nonalphanumeric keys' were not amended or argued in the original prosecution to overcome an art rejection." (Emphasis added). This is not the standard of the Federal Circuit. Instead, the proper question is whether a new limitation distinguishes over the prior art in the same way as a limitation added during prosecution.

C. Assuming The Board's Standard for Surrender under Substep 3(a), There Is Still No Recapture Because The Reissue Claims Do Fall Under Substep 3(b)

Should the Board not agree with the foregoing concerning the standard of surrender under substep 3(a), appellants' reissue claims still avoid recapture because they fall under substep 3(b). The language of *Clement's* substeps 3(a) and 3(b) focus not on whether the narrowing is with respect to surrendered subject matter, but rather whether the narrowing is with respect to a "prior art rejection." The Examiner focused on the elimination of the "cycling" feature and concluded that substep 3(a) applied. This was an error. The Examiner has not shown, because it is not the case, that the reissue claims meet the other requirement of substep 3(a) - that the reissue claims are "narrower in another aspect completely unrelated to the rejection." Instead, the claims meet the literal language of substep 3(b) and avoid recapture. They are narrower than the amended claim (i.e., the original application claim) "in an aspect germane to a prior art rejection." They require the claimed "wireless remote control," "non-alphanumeric

keys," and "changing" features.³¹ They are broader than the original application claim "in an aspect unrelated to the rejection," because they removed the claimed "video display generator means" and "data processing means."

D. The Reissue Claims Avoid Recapture Even When The "Overlooked Aspect" Standard Is Applied

The Examiner appears to limit "overlooked aspects" to only "unclaimed additional inventions/embodiments/species."³² Even if that standard were applied to appellants' case, where surrender occurred through claim amendment, appellants' narrowing limitations introduced during reissue would still constitute limitations claiming an "overlooked aspect of the invention."

The *Hester* court explained that the "overlooked aspect" principle exists "to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects."³³ In *Hester*, the applicant attempted to obtain reissue claims directed to a high humidity steam cooker based on narrowing limitations defining a

³¹ The "wireless remote control" and "nonalphanumeric keys" limitations are make the claims narrower, in a manner related to the prior art rejection, than the issued patent claims.

³² See Examiner's Answer at 4-5 (citing MPEP § 1412.02 for standard defining how capture can be avoided under step 3); MPEP § 1412.02(I.C) (8th ed., Rev. 7, July 2008) ("If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.").

³³ *Id.* at 1483.

"spiral conveyance path" and "high humidity steam."³⁴ However, the Federal Circuit found that such limitations did not allow the applicant to avoid recapture because they were not directed to "overlooked aspects" of the invention. Rather, both limitations were present in original claim 1 of the patent application, and indeed the "spiral conveyance path" was repeatedly discussed during prosecution in an attempt to overcome the Examiner's obviousness rejection.³⁵

In contrast, appellants are now seeking an embodiment of its character selection technique that was not specifically claimed during the original patent prosecution. Nowhere in the original application or prosecution history did appellants claim the "wireless remote," "nonalphanumeric keys," or "changing" limitations now present in the reissue claims. Thus, these limitations are "materially narrowing" at least because they claim an embodiment of the invention overlooked during original prosecution. Indeed, this fact is conceded³⁶ by the Examiner, who points out that the added character selection technique was not amended or argued in the original prosecution to overcome an art rejection. Thus, even applying the Board's recapture standard, appellants' reissue claims still avoid recapture at least because they include material, "overlooked aspects" of the invention.

³⁴ *Id.*

³⁵ *Id.*

³⁶ Examiner's Answer at 6-7.

VII. Conclusion

In view of the foregoing, contrary to the Examiner's allegations in the Examiner's Answer, appellants have not improperly recaptured surrendered subject matter in this reissue application. For at least the foregoing reasons and the reasons set forth in the Appeal Brief, appellants respectfully submit that the Board should find the rejection of independent claims 24 and 40 under 35 U.S.C. § 251 to be in error and should reverse the Examiner. Appellants respectfully submit that claims 1-27, 29-43, and 45-55 are in condition for allowance.

Respectfully submitted,

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